

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

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BT

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/597,796 06/20/00 SKEIKY
020350 HM12/0531
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EIGHTH FLOOR
SAN FRANCISCO CA 94111-3834

Y 014058-00905

EXAMINER

SWARTZ, R

ART UNIT	PAPER NUMBER
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1645

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DATE MAILED:

05/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/597,796 Applicant(s) Skeiky et al

Examiner Rodney P. Swartz, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims 1-54 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152) _____
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) Other: *Sequence Requirement Letter*

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, drawn to protein composition, classified in class 424, subclass 248.1.
 - II. Claims 16-28, drawn to DNA composition, classified in class 436, subclass 23.7.
 - III. Claims 29-41, drawn to method of immunizing using protein, classified in class 424, subclass 9.2.
 - IV. Claims 42-54, drawn to method of immunizing using DNA, classified in class 514, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are drawn to structurally and functionally distinct molecules. Invention I is drawn to amino acids while Invention II is drawn to nucleic acids.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the proteins of Invention I can be utilized *in vitro* for immunoassays to detect infection of a subject with *Mycobacterium*.

Inventions I and IV are drawn to structurally and functionally distinct molecules. Invention I is drawn to amino acids while Invention IV is drawn to nucleic acids.

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Inventions II and III are drawn to structurally and functionally distinct molecules.

Invention II is drawn to nucleic acids while Invention III is drawn to amino acids.

Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the DNA of Invention II can be used *in vitro* to produce proteins for use in immunoassays to detect infection of a subject with *Mycobacterium*.

Inventions III and IV are drawn to patentably distinct methods utilizing different reagents. Invention III utilizes amino acids, Invention IV utilizes nucleic acids.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CAR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a petition under 37 CAR 1.48(b) and by the fee required under 37 CAR 1.17(I).

Sequence Requirements

2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. §1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. §§1.821-1.825 for the reason(s) set forth on the attached Notice to Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Compliance with the sequence rules is required in response to this office action.

Failure to comply with the sequence rules in response to this office action will be considered nonresponsive. Sequence compliance should accompany the response to rejections set forth below.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney P. Swartz, Ph.D., whose telephone number is (703) 308-4244. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith, can be reached on (703)308-3909. The facsimile telephone number for the Art Unit Group is (703)308-4242.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.

Rodney P Swartz
RODNEY P SWARTZ, PH.D
PRIMARY EXAMINER

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May 31, 2001